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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,902

06/21/2006

Alain Burgos

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MERCHANT & GOULD PC

P.O. BOX 2903

MINNEAPOLIS, MN 55402-0903

EXAMINER

KATAKAM, SUDHAKAR

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

07/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Status of the application

1. Receipt of Applicant's Remarks and Arguments filed on 31st March 2009 is acknowledged. However, the arguments for the rejections are not found persuasive and as such, the previous rejection has been maintained for the reasons of record made on 31st Dec 2008.

Response to Arguments

2. Applicant's arguments filed on 31st March 2009 have been fully considered but they are not persuasive.

Applicants argue that the Johnson process has two different reaction steps in making eneamide derivatives, Johnson alleges to produce a moderate to good yield (40-85%) during step (A), and Johnson et al uses a molar proportion of the catalyst which is twice that of the oxime.

Johnson et al clearly suggested, to a skilled person in the art, a process for the production of enamide derivatives, prepared by reduction of oximes with a reducing metal in the presence of an acylating agent. The catalyst used is a complex of a transition metal M^{2+} and a chiral phosphine ligand. The reaction temperature is at moderate temperatures = 75°C, with moderate to good yields (40-85%, unoptimized) and in a high state of purity. **Johnson et al** also exemplifies the synthesis of N-(3,4-dihydronaphthalen-1-yl)-acetamide using Fe as the catalyst. Included is a washing step containing sodium hydroxide and the acyl derivative (acetic anhydride and acetic acid) is used as the solvent.

With regard to process steps, one step process is obvious over two step process, because in the one pot process the multi-steps manipulated in one step, which mean the reactant and intermediates further proceed to the next step for the completion to achieve the final product.

With regard to the applicants' comparative experiments and statements on the difference in reaction process, please note that the mere statements by the inventors are not supported by evidence. These should be in the form of either a declaration or an affidavit.

Applicants show how each cited reference differ from the instant invention, but the obviousness test under 35 U.S.C. 103 is whether the invention would have been obvious in view of the prior art taken as a whole. In re Metcalf et al. 157 U.S.P.Q. 423.

Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, it is permissible for the Examiner to rely on disclosures, which fairly teach embodiments of Applicant's invention. The claims require a multitude of elements and it is reasonable for one of ordinary skill in the art to consider these elements being used together.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Johnson et al** (WO 99/18065), in view of **Tinsley et al** (US 3,375,287) for the reasons of record as set forth in the office action on 31st Dec 2008.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no even, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. No claim is allowed in absence of a clear delineation of the claims from the prior art and a side by side showing of unexpected results commensurate in scope of the claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Sudhakar Katakam/
Examiner, Art Unit 1621

/Peter G O'Sullivan/

Primary Examiner, Art Unit 1621